

REMARKS/ARGUMENTS

The amendment to Claim 1 is supported by Claim 19, now cancelled. New Claims 20-24 are supported by specification page 14, line 8 – page 17, line 8 detailing preferred friction modifiers (C). No new matter has been entered. An RCE has been filed herewith in order to ensure the entry of the amendment and the new claims.

The new grounds of rejection based on Suekuni in light of evidence provided by KIC Chemicals, optionally further in view of Tagliamonte, Baba, and the new grounds of rejection based on Denpo in view of Bialas, optionally further in view of Egawa or Baba, are traversed. These rejections, set out in paragraphs 2, 3, 4, 6, 7, and 8 of the Final Official Action, were not applied against the subject matter of Claim 19, now incorporated in presently amended Claim 1. Accordingly, these rejections are no longer applicable, and they should be withdrawn.

The rejection of Claim 19 over Suekuni in view of Papay in light of evidence provided by KIC Chemicals (paragraph 5 of the Official Action), and the rejection of Claim 19 over Denpo in view of Bialis further in view of Papay (paragraph 9 of the Official Action) are traversed.

As recognized by the Examiner, Suekuni does not disclose or suggest the inclusion of a phosphate-based friction modifier. Papay generally discusses friction modifiers at column 46, lines 55 ff and identifies alkyl phosphonates. Notably, Applicants' amine salts are not disclosed or suggested in Papay (see, e.g., new Claim 21). Moreover, and more importantly, it is to be recognized that the lubricating oil compositions of Papay are different in *kind* from those in Suekuni. Specifically, the Suekuni lubricants are conductive lubricants while the Papay lubricating oil compositions are not. Because the lubricating compositions described in the two references are different and distinct from one another and have achieved a separate status in the art in view of their disparate uses, one of ordinary skill would not be motivated

to use specialized components of one composition in the other without specific motivation and/or guidance to do so. Because this motivation and/or guidance is lacking, the combination of references fail to present a *prima facie* case of obviousness against the currently pending claims.

In addition to the lack of an established *prima facie* case of obviousness, Applicants have shown that when a friction modifier (C) as presently claimed is used in a conductive lubricant composition comprising presently claimed components (A) and (B) that excellent volume resistivity is obtained. See, for example, Examples 9 and 12 herein (specification page 29), noting that Friction modifier A is a phosphate ester amine salt, as claimed. As nothing in the combination of prior art applied against prior Claim 19 suggests this result, this evidence overcomes any question regarding the patentability of the presently claimed conductive lubricant composition. Thus, the rejection of Claim 19 over Suekuni in view of Papay in light of evidence provided by KIC Chemicals (paragraph 5 of the Official Action) should be withdrawn.

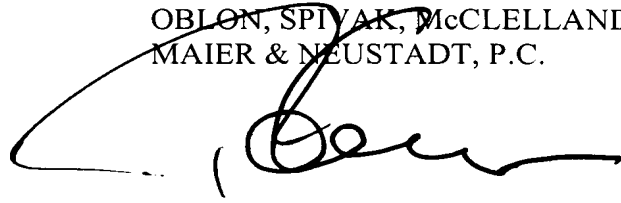
With regard to the rejection of Claim 19 over Denpo in view of Bialas further in view of Papay, Applicants again note that the issues are similar to those discussed immediately above, and that the Papay reference does not relate to a conductive lubricant composition and thus would not be viewed as disclosing or suggesting ingredients useful in such a composition. Moreover, and as shown herein, the presently claimed invention achieves particularly excellent volume resistivity results, which are nowhere disclosed or suggested by even the combination of Denpo, Bialas and Papay. For these reasons the rejection should be withdrawn.

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Reply to Office Action of February 3, 2009

Accordingly, and in view of the above amendment and remarks, Applicants respectfully submit that the present application is in condition for allowance, and early notification to this effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Treanor', is written over a horizontal line. The signature is stylized with a large initial 'T' and a cursive 'reanor'.

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